



**Reply Under 37 C.F.R. § 1.116
Expedited Procedure – Art Unit 3634**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:
Christina Moschella
Appl. No.: 10/775,954
Filed: February 11, 2004
For: **Privacy Shade**

Confirmation No.: 1663
Art Unit: 3634
Examiner: Blair M. Johnson
Atty. Docket: 2255.0010001/DRB

Reply Under 37 C.F.R. § 1.116

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Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the Office Action dated June 14, 2005, Applicant submits the following Remarks.

It is not believed that extensions of time or fees for net addition of claims are required beyond those that may otherwise be provided for in documents accompanying this paper. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to our Deposit Account No. 19-0036.

Remarks

Reconsideration of this Application is respectfully requested.

Claims 1, 7-11, and 17-28 are pending in the application, with claims 1 and 11 being the independent claims. Based on the following remarks, Applicant respectfully requests that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Applicant's representative thanks the Examiner for the courtesies extended during the telephone interview on September 13, 2005. During the interview, Applicant's representative argued that neither of the cited references provide motivation or suggestion for attaching a piece of lightweight, flexible material to a top portion of a computer monitor or display device by a hook and loop fastener as claimed. The Examiner requested that Applicant file a response to the outstanding Office Action so that the Examiner could reconsider his rejection.

Rejection under 35 U.S.C. § 103

Claims 1, 7-11 and 17-28 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,188,450 to Coons (the "The Coons patent") in view of U.S. Patent No. 5,499,793 to Salansky ("the Salansky patent").

The Examiner argues that the Coons patent discloses "most of the structure" of the claimed invention "by providing a flexible screen attached to the top of a computer monitor." (Office Action at 2). The Examiner further argues that the Salansky patent "teach[es] the use of hook and loop fasteners to attach a monitor accessory to a monitor." (Office Action at 2). Accordingly, the Examiner concludes that "it would have been

obvious to use [hook and loop] fasteners to attach the cover 21 of the Coons patent to the monitor." (Office Action at 2). Applicant traverses this rejection.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

MPEP § 2142 (citing to *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)).

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references."

MPEP § 2142 (citing to *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985)).

The Examiner has failed to meet this burden. Without more evidence of unpatentability, Applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

Independent claims 1 and 11 require that a piece of lightweight, flexible material is attached to a *top portion* of a computer monitor or display device by a hook and loop fastener. The Coons patent does not disclose attachment of a lightweight, flexible material to a *top portion* of a computer monitor or display device by a hook and loop fastener, as claimed.

Contrary to the Examiner's contention, the Coons patent does not disclose attaching screen shield 21 to a *top portion* of a computer monitor or display device. In fact, The Coons patent provides no motivation or suggestion to attach screen shield 21 to any part of monitor 11. Rather, Col. 4, ln. 25-35 of the Coons patent discloses that screen shield 21 is secured to the top front corners of side covers 16a, 16b, which are, in turn, secured in place *on the sides* of monitor 11 by use of securing straps 28 and/or held in place by the addition of screen frame piece 27, which, as shown in Fig. 1 is disposed *on the front* of monitor 11. Contrary to the Examiner's contention, the specification of the Coons patent makes it clear that Figs. 1 and 2 of the Coons patent *do not* disclose attachment of screen shield 21 to a *top portion* of computer monitor 11.

Further, the Examiner incorrectly argues that "the use of a shade of the Coons patent alone without the entire cover is clearly obvious." (Office Action at 3). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780, 1783-84 (Fed.

Cir. 1992). There is no embodiment in the Coons patent in which screen shield 21 is used alone. Additionally, there is no suggestion or motivation in the Coons patent to use screen shield 21 alone. Rather, use of screen shield 21 alone, as the examiner suggests, would destroy the teaching of the Coons patent, namely, that screen shield 21 should be secured to the top front corners of side covers 16a, 16b.

Accordingly, the Coons patent fails to disclose attachment of a lightweight, flexible material to a *top portion* of a computer monitor or display device, as claimed, and provides no motivation or suggestion for the use of a hook and loop fastener for such attachment.

The Examiner relies on the Salansky patent for the general teaching of the use of hook and loop fasteners for attaching computer accessories to a computer monitor. (Office Action at 2). However, there is no teaching or suggestion in the Salansky patent to modify the structure of the Coons patent as the Examiner has suggested, to attach screen shield 21 to a *top portion* of computer monitor 11, rather than secured to the top front corners of side covers 16a, 16b, as disclosed in the Coons patent. The Examiner provides no motivation or suggestion, other than impermissible hindsight based on Applicant's disclosure, that would lead one of ordinary skill in the art to adopt features of the document holder disclosed in the Salansky patent when looking to improve upon the framework of the CRT cover disclosed in the Coons patent.

As the Federal Circuit has held numerous times, this type of hindsight analysis is impermissible -- to support a prima facie case of obviousness, the suggestion or motivation to make and use a claimed invention must come from the prior art itself, and not from Applicant's own teachings. *See In re Pleuddemann*, 910 F.2d 823, 828, 15

U.S.P.Q.2d 1738, 1742 (Fed. Cir. 1990) (noting that use of an applicant's specification as though it were prior art to support an obviousness determination is legal error); *see also In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991) (stating that both the suggestion and reasonable expectation of success in making a claimed composition "must be founded in the prior art, not in the applicant's disclosure"). "It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 972 F.2d at 1266, 23 U.S.P.Q.2d at 1784.

For at least these reasons, independent claims 1 and 11 and claims 7-10 and 17-28 which depend therefrom, are patentable and Applicant respectfully requests that the Examiner reconsider the rejection and that it be withdrawn.

Additionally, Applicant notes that the Examiner has not specifically addressed new claims 21-24 that were presented in Applicant's March 22, 2005 Amendment and Reply. In particular, the Examiner has failed to present a *prima facie* case of obviousness with respect to the additional limitations recited in claims 21-24. As discussed above, neither of the cited references provide motivation or suggestion for attaching a lightweight, flexible material to a *top portion* of a computer monitor or display device, as claimed. Additionally, in view of the teaching of side panels 16a, 16b in the Coons patent and attachment frame 5 of the Salansky patent, there is no motivation or suggestion in either cited reference for attaching a lightweight, flexible material *directly* to a top portion of a computer monitor or display device, as recited in claims 21-24, such that one portion of a hook and loop fastener is placed on a top portion of a computer monitor or display device and the other portion of the hook and loop fastener is

placed on a top portion of the lightweight, flexible material. For at least these reasons, dependent claims 21-24 are patentable and Applicant respectfully requests that the Examiner reconsider the rejection if these claims and that it be withdrawn.

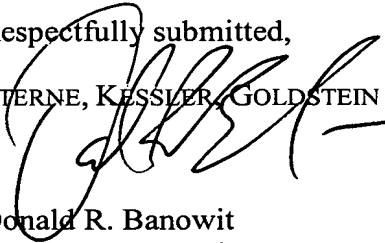
Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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